

Appl. No. 10/763,873
Reply to Office Action dated 9/27/05
Amendment dated December 27, 2005

Amendments to the Drawings:

The attached sheets of drawings include changes to FIGS. 1 and 2. These sheets, which include FIGS. 1-2, replaces the original sheets including FIGS. 1-2. In FIG. 1, the legend, "Prior Art" is added. In Figure 2, previously omitted element 101 has been added.

Attachment: Replacement Sheets

Appl. No. 10/763,873
Reply to Office Action dated 9/27/05
Amendment dated December 27, 2005

REMARKS

Reconsideration of this application is respectfully requested.

Claims 9 and 10 were improperly withdrawn from consideration by the Examiner. Claims 1-4, 7-11 and 14 are generic to all of the species identified in the election requirement. Therefore claims 9 and 10 read on both elected species. Applicant is entitled to examination of claims 9 and 10.

The drawings were objected to because FIG. 1 was not labeled as prior art. FIG. 1 is now labeled as prior art.

The drawings were objected to because reference numeral 100 was referred to as an apparatus and as insulation. FIG. 2 is amended to add the reference numeral 101 for the apparatus. The specification is amended to change "apparatus 100" to "apparatus 101".

The drawings were objected to because reference numeral 26 was not shown in FIGS. 3A to 5. Paragraph [0023] is amended to reference FIGS. 3A to 8, and specifically FIG. 6, which includes reference numeral 26.

The drawings were objected to because reference numeral 28 was not shown. The specification was amended to change "28" to "22."

In view of the foregoing, withdrawal of the objections to the drawings is respectfully requested.

Claims 1-4 and 28 were rejected under 35 U.S.C. § 102 as being anticipated by Nakaya (US 4,781,091).

Amended claim 1 recites: "a rotary die cutting cylinder located along a path of the conveying means and having at least one cutting rule that severs said insulation, and at least one of the group consisting of a perfining rule and a slicing rule sized to partially cut through said insulation, without cutting through a complete depth of said insulation." Support is provided in paragraphs [0023] and [0024].

Appl. No. 10/763,873
Reply to Office Action dated 9/27/05
Amendment dated December 27, 2005

Nakaya neither discloses nor suggests this feature. The Action alleges that item 8 in Nakaya is a cutting rule and a slicing rule. However, the claimed slicing rule is not the same as a cutting rule, as defined in the specification and now expressly required by claim 1. Nakaya's cutting rule 8 completely severs the veneer. The other item 8 in Nakaya is merely another cutting rule sized to completely sever the veneer, and is not "a slicing rule sized to partially cut through said insulation, without cutting through a complete depth of said insulation," as required by claim 1.

Further, the allegation in the action that "Nakaya discloses an apparatus for manufacturing insulation," is not correct. Nakaya makes no mention of insulation whatsoever, and makes no suggestion as to how his apparatus could be modified to process insulation.

Therefore, amended claim 1 is not anticipated by Nakaya.

Claims 2-4 and 28 are dependent on claim 1, and are not anticipated for at least the same reasons as claim 1.

Claims 5 and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over Nakaya in view of Marco (US 5,211,711). Amended claim 5 recites, "The apparatus of claim 1, wherein the rotary die cutting cylinder includes two cutting rules, and six perfining rules with steps along a length thereof." Support for the amendment is provided by FIG. 3B, which shows an example of a perfining blade 22 with steps along its length. Amended claim 13 also requires that "the perfining rules having steps along lengths thereof."

The action admits that Marco fails to disclose or suggest six perfining or slicing rules and two cutting rules. Marco was cited for showing perfining rules. However, Marco fails to cure the deficiency of Nakaya with respect to amended claim 5. Marco neither discloses nor suggests a perfining rule having steps along a length thereof. Marco shows knife assemblies 120 having relatively short knives. But there is no suggestion in Marco of a perfining blade having steps along a length thereof. Nor would there be any motivation to modify Marco's knives to include the steps. Marco uses his knives to cut a slit in a thin plastic film along its side edge (a direction that is orthogonal to the cutting direction in Nakaya). It would be impractical to use a stepped blade to make a cut in the side edge of a thin film, and there would be no advantage to doing so.

Appl. No. 10/763,873
Reply to Office Action dated 9/27/05
Amendment dated December 27, 2005

Moreover, one of ordinary skill in the art would not have been motivated to modify the combined teachings of these two references to achieve the claimed invention as suggested by the Action. Nakaya is directed towards a conveyor system for cutting a thin veneer. Nakaya makes no suggestion of slicing partially through the veneer or perfining the veneer. There would be no motivation to do so. Partial slices or perforations in a usable portion of a veneer would be unsightly, and could also reduce the protective properties provided by a veneer. For that reason, veneers are generally cut to the actual size used, instead of partially slicing or perforating the veneer in advance. Marco, on the other hand, is directed to an apparatus for forming slits in the webs of beverage container carriers. Because the carriers are disposable items of no decorative value, there is no disincentive to making the slits in the film in advance of its use. Because these applications are so different, there would be no motivation to modify the combined teachings as suggested.

Further, one of ordinary skill would not be motivated to combine the teachings of these two references in the first instance. Nakaya also goes to great lengths to show that the control devices and clutch/break assembly are crucial in controlling the ability of the device to cut the continuous material to desired predetermined length. In the Marco patent, it is the "Star Wheel"'s engagement of the actual product in the web (and not the web material itself) that allows it to position its blades for cutting in the proper locations, not anything that has to do with the web (or "Carrier Stock" as they describe it). Thus, one of ordinary skill would not be motivated to combine teachings from these two very different mechanisms.

Therefore, claim 5 is patentable over the Nakaya in view of Marco.

Claims 7 and 11 were rejected under 35 U.S.C. § 103 as being unpatentable over Nakaya. Claims 7 and 11 are dependent on claim 1, and should be patentable over Nakaya for the same reasons discussed above with respect to claim 1.

Claims 14 and 15 were under 35 U.S.C. § 103 as being unpatentable over Nakaya in view of Ohara (US 5,695,105). This rejection is respectfully traversed.

The Action argues that the use of different conveying speeds "could be easily implemented in the Nakaya device due to the location of the two conveyors (4 and 5)." Whether

Appl. No. 10/763,873
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a change can be implemented easily is not a substitute for showing obviousness of the claimed invention. Even if the proposed modification could have been implemented easily, that is not a substitute for a showing that the prior art contained some suggestion or motivation for the modification proposed by the Patent and Trademark Office.

On the contrary, there would have been no suggestion or motivation for one of ordinary skill in the art to have done so. Nakaya teaches a cutting blade for completely severing a veneer. There would have been no reason for one of ordinary skill in the art to increase the complexity of Nakaya's apparatus by installing a perfin blade that does not completely sever the veneer, and installing a more complex system having conveyors operating at two different speeds, in order to complete the tearing of the perforated veneer, which would be completely unnecessary if Nakaya's cutting blade is simply left in place.

Therefore, a prima facie case of obviousness has not been established with respect to claims 14 and 15.

Applicants note that no prior art has been applied against claims 6, 8 or 16. Because no prima facie case of obviousness has been established with respect to these claims by the Patent and Trademark Office, claims 6, 8 and 16 should all be allowed.

Claims 1-4, 7-11, 14-17 and 28 are generic to Species 3, 4, and 5, and claims 1-14 and 28 are generic to Species 6, 7 and 8. Claims 1-4, 7-11 and 14 are generic to all of the species. Applicant submits that all of the generic claims 1-4, 7-11 and 14 are allowable for the reasons set forth above. Therefore, applicant requests examination and allowance of the dependent claims 9, 10, 12, 16 and 17, which variously depend from the generic base claims.

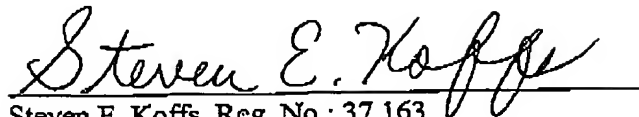
In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for examination.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account 04-1679.

Appl. No. 10/763,873
Reply to Office Action dated 9/27/05
Amendment dated December 27, 2005

Respectfully submitted,

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